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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,108	07/28/2003	Kazuo Koyama	03338CIP/HG	6344
1933	7590	06/17/2005	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 5TH AVE FL 16 NEW YORK, NY 10001-7708			SOLOLA, TAOFIQ A	
			ART UNIT	PAPER NUMBER
			1626	
DATE MAILED: 06/17/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/629,108

Applicant(s)

KOYAMA ET AL.

Examiner

Taofiq A. Solola

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 17 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 46-118 is/are pending in the application.
- 4a) Of the above claim(s) 93-118 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) 46-92 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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Claims 1-45 are cancelled.

Claims 46-119 are pending in this application.

Claims 93-119 are drawn to non-elected invention.

### ***Objection***

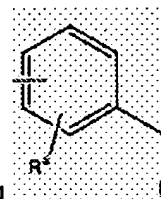
Claims 46-92 and 119 are objected to for containing non-elected subject matter. To place the application in condition for allowance, applicant must amend the claims as set forth under Status of Claims in the last Office action.

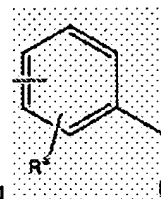
### ***Rejoinder***

Claims 93-118 would be rejoined following allowability of claims 46-92 and 119 provided there is no problems under 35 USC 112.

Applicant's arguments filed 5/17/05 have been fully considered but they are not persuasive. Applicant contends that election of species became a restriction, and restriction between groups I and II was not in the restriction requirement. This is not persuasive for reasons set forth in the restriction requirement with particular reference to pages 2-3. Applicant reliance on the MPEP 802.03 may be the problem here since there is no such section in the MPEP. The related section of the MPEP is 803.02, to which applicant's attention was directed in the last Office action but apparently ignored.

Claims 46-52 and 84 are not proper Markush Claims under the MPEP 803.02 because the formulae in the claims are not substantial structural feature, and the specification fails to disclose any utility attributable to the formulae.



The common structure in each of claims 46-52 and 84 is the following . This does not constitute a substantial structural feature under the meaning of the MPEP 803.02. The specification fails to disclose any utility arising from the formula and is not searchable. Any attempt to search it would run the computer out of memory. Hence, the restriction. Applicant was invited to develop this formula to the point it can be searched and if found novel would obviate the need for further restriction. See the restriction requirement at page 4. Applicant fails to avail him/herself of the invitation. MPEP 803.02 states that if an elected species is found novel, additional species must be searched but such would not be "extended unnecessarily to cover all non-elected species." Therefore, Applicant should consult this section of the MPEP. Should applicant need help in interpreting this section the Examiner may be contacted for assistance. Applicant should note that all the variables in the formulae of claims 46-52 and 84 do not count as part of the substantial structural feature under the meaning of the MPEP 803.02 because what is required is "a" substantial structure not substantial structure"s". For example, the variable Ra in the above formula does not count.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, JD, whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

  
**TAOFIQ SOLOLA**  
**PRIMARY EXAMINER**  
Group 1626

June 13, 2005